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**OFFICE OF PETITIONS**

In re Application of :  
Jose Walter :  
Application No. 09/909,893 :  
Filed: July 23, 2001 :  
Attorney Docket No. Walter artic. :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed on July 19, 2006, to revive the above-identified application.

The application became abandoned on August 19, 2003, as a result of petitioners' failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within two (2) months of the Notice of Appeal filed on June 18, 2003 (certificate of mailing dated June 16, 2003). The Office mailed a Notice of Abandonment on February 24, 2004.

Initially, the Office notes that petitioners indicated in the petition that the present nonprovisional application was assigned to Cbite, Inc. Santiago Balleza is the president of Cbite and the inventor, Jose Walter, is the vice-president. The USPTO assignment records do not indicate that Balleza, Walter or Cbite (also referred to as "petitioners") recorded the assignment with the Office to date.

The patent attorney of record, Glenna Hendricks, stated that on June 18, 2003, (the same day she filed the Notice of Appeal and Response), she sent a letter to Balleza and Walter, in which she enclosed a copy of the correspondence filed with the USPTO on June 16, 2003, and suggested a petition be filed relating to the entry of amended claims. Hendricks further stated that on August 1, 2004, she sent a second letter to Balleza and Walter, advising them that the application would become abandoned unless action was taken in the form of filing either a continuation application or an Appeal Brief. Hendricks asserted that she received no answer to either letter. Redacted copies of the letters accompany the petition. Hendricks asserted that during the extendable period for filing an Appeal Brief, she spoke to Walter to determine how petitioners intended to proceed; however, Walter informed her that petitioners were making changes and that costs were a major concern of petitioners. Hendricks stated that she believed that petitioners either did not intend to prosecute the application; changed attorneys; or were pursuing the matter on their own.

In a declaration submitted with the petition, Balleza explained that on May 1, 2002, and November 1, 2002, petitioners had moved the company twice and were in the process of moving the office. Balleza indicated that during that period there was some confusion in the office and that it appeared that communications from Hendricks were lost. Balleza stated: "In March of 2006, I understood, in a conversation with Ms. Hendricks, our patent attorney, that the application had gone abandoned, that she had filed a Notice of Appeal and that we had never given her permission to take action required to maintain the application." Balleza asserted that a search of petitioners' property led him to believe that the correspondence from Hendricks to them must have been lost because he could not find her letters. Lastly, Balleza stated that at not time did Cbite intend to abandon the application and the abandonment was contrary to their intentions.

## DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".<sup>1</sup> Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>2</sup>

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<sup>1</sup> 35 U.S.C. § 133.

<sup>2</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).<sup>3</sup> Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>4</sup>

It appears that petitioners are asserting that the delay was unavoidable because they did not receive or lost the correspondence during their two moves, informing them of the status of the application and the necessary actions to be taken to avoid abandonment. Nevertheless, the showing of record is that the delay in taking action in the above-identified application was the result of petitioners' preoccupation with other matters. The Office notes that petitioners' preoccupation with other matters, which took precedence over the present application, does not constitute unavoidable delay.<sup>5</sup> Additionally, petitioners are reminded that the failure of communication between an applicant and counsel is not unavoidable delay within the meaning of 37 CFR 1.137(a).<sup>6</sup> There is nothing in the record to indicate that petitioners contacted their patent attorney and informed her of their change of address. Moreover, there is no showing that petitioner took any action to prevent the application from becoming abandoned such as simply inquiring into its status. An applicant may delay action until the end of the time period for reply. In doing so, however, the applicant must assume the risk attendant to such delay.<sup>7</sup>

The general standard applied by the Office requires petitioners to establish that they exercised the care and diligence in prosecuting the present application that is generally used and observed by prudent and careful men in relation to their most important business.<sup>8</sup> Lack of knowledge of the content of, or misunderstanding of the patent statutes, rules or the MPEP does not constitute unavoidable delay.<sup>9</sup>

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by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>3</sup> See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

<sup>4</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

<sup>5</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>6</sup> In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

<sup>7</sup> Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

<sup>8</sup> In re Mattullah, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)).

<sup>9</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

According to Hendricks, during the extendable period for filing an Appeal Brief, she spoke to Walter to determine how petitioners intended to proceed; however, Walter informed her that petitioners were making changes and that costs were a major concern of petitioners. Therefore, petitioners first became aware of the status of the application and the need for action on or before January 18, 2004. Yet, petitioners did not take any action in the application until the filing of the present petition, approximately 2.5 years later. The record does not show that petitioners made any effort to communicate with their designated legal representative or to ensure that a timely response was filed to avoid abandonment of this application. Petitioners' inaction does not demonstrate the care and diligence generally observed by prudent and careful men in relation to their most important business. Regardless of the events surrounding the company's two moves, a reasonable and prudent person would have informed their attorney of the change of address, as well as ascertain information regarding the status of the application either through their attorney or by contacting the USPTO. Finally, the Office reminds petitioners that an intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.<sup>10</sup>

An applicant has a duty to ensure that his application is being prosecuted.<sup>11</sup> "Diligent inquiry into the status of the application is required."<sup>12</sup> Therefore, petitioners must establish with a documentary showing that they exercised diligence in attempting to further the prosecution of the above-identified application.

## CONCLUSION

Petitioners have not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Accordingly, the petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

## ALTERNATIVE VENUE

Petitioners may wish to file a petition under 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by:

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<sup>10</sup> See In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988); see also MPEP 711.03(c)(II)(C)(2).

<sup>11</sup> Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 USPQ2d 1687, 1700 (E.D. Pa. 1991), aff'd, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992); citing Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1962).

<sup>12</sup> Id.

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to 37 CFR 1.137 (d).

Additionally, petitioners should submit additional information or a further explanation as to why the delay was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
                                    Alexandria, VA 22313-1450

By FAX:                      (571) 273-8300  
                                    Attn: Office of Petitions

By hand:                     Customer Service Window  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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